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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,772	06/27/2003	Joanne Fillatti	16518.070	6379

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EXAMINER

MCELWAIN, ELIZABETH F

ART UNIT PAPER NUMBER

1638

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/606,772

Applicant(s)

FILLATTI, JOANNE

Examiner

Elizabeth F. McElwain

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 49-97 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 49-97 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 49, 50, 52-59, 61-63 and 97, drawn to a soybean plant comprising a promoter operably linked to a polynucleotide having at least 70% identity to SEQ ID NO: 2 (fad2) and exhibiting 26-80% oleic acid, about 2.97-49.92% linoleic acid, and about 3.38-8.81% linoleic, classified in class 800, subclass 312, for example.
  - II. Claims 49, 51, 52-58, 60-63 and 97, drawn to a canola plant comprising a promoter operably linked to a polynucleotide having at least 70% identity to SEQ ID NO: 2 (fad2) and exhibiting 26-80% oleic acid, about 2.97-49.92% linoleic acid, and about 3.38-8.81% linoleic, classified in class 800, subclass 312, for example.
  - III. Claims 58, 59, 62, 64 and 97, drawn to a soybean plant comprising a promoter operably linked to a fad3 intron, and exhibiting 26-80% oleic acid, about 2.97-49.92% linoleic acid, and about 3.38-8.81% linoleic, and a method of making said plant, classified in class 800, subclass 312, for example.
  - IV. Claims 58, 60, 62, 64, 97, drawn to a canola plant comprising a promoter operably linked to a fad3 intron and exhibiting 26-80% oleic acid, about 2.97-49.92% linoleic acid, and about 3.38-8.81% linoleic, and a method of making said plant, classified in class 800, subclass 312, for example.

- V. Claims 65, 66, 68-75 and 77-79, drawn to a soybean plant comprising a promoter operably linked to a polynucleotide having at least 70% identity to SEQ ID NO: 2 (fad2) and exhibiting 50-75% oleic acid, about 10-30% linoleic acid, and about 3% linoleic, classified in class 800, subclass 312, for example.
- VI. Claims 65, 67-74 and 76-79, drawn to a canola plant comprising a promoter operably linked to a polynucleotide having at least 70% identity to SEQ ID NO: 2 (fad2) and exhibiting 50-75% oleic acid, about 10-30% linoleic acid, and about 3% linoleic, classified in class 800, subclass 312, for example.
- VII. Claims 74, 75, 78 and 80, drawn to a soybean plant comprising a promoter operably linked to a fad3 intron and exhibiting 50-75% oleic acid, about 10-30% linoleic acid, and about 3% linoleic, classified in class 800, subclass 312, for example.
- VIII. Claims 65, 67-74 and 76-79, drawn to a canola plant comprising a promoter operably linked to a fad3 intron and exhibiting 50-75% oleic acid, about 10-30% linoleic acid, and about 3% linoleic, classified in class 800, subclass 312, for example.
- IX. Claims 81, 82, 84-91 and 93-95, drawn to a soybean plant comprising a promoter operably linked to a polynucleotide having at least 70% identity to SEQ ID NO: 2 (fad2) and exhibiting 80-85% oleic acid, about 1-2% linoleic acid, and about 1-3% linoleic, classified in class 800, subclass 312, for example.
- X. Claims 81, 83-90 and 92-95, drawn to a canola plant comprising a promoter operably linked to a polynucleotide having at least 70% identity to SEQ ID NO: 2

(fad2) and exhibiting 80-85% oleic acid, about 1-3% linoleic acid, and about 3% linoleic, classified in class 800, subclass 312, for example.

XI. Claims 90, 91 and 96, drawn to a soybean plant comprising a promoter operably linked to a fad3 intron and exhibiting 80-85% oleic acid, about 1-2% linoleic acid, and about 1-3% linoleic, classified in class 800, subclass 312, for example.

XII. Claims 90, 92 and 96, drawn to a canola plant comprising a promoter operably linked to a fad3 intron and exhibiting 80-85% oleic acid, about 1-3% linoleic acid, and about 3% linoleic, classified in class 800, subclass 312, for example.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I-XII are directed to related products. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j). In the instant case, the claimed plants are different plant species differing genetically and phenotypically and are not obvious variants and are not capable of use together. The claimed inventions are capable of being separately made, independently used and the patentability of one does not render the others obvious or unpatentable.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and the requirement for different searches, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth F. McElwain whose telephone number is (571) 272-0802. The examiner can normally be reached on increased flex time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on 571-272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Elizabeth F. McElwain

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Ph.D. Level Examiner  
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EFM